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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,130	08/08/2006	Richard Twomey	DEP5008	6010
27777 7590 08/01/2008 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER				
SCHILLINGER, ANN M				
ART UNIT		PAPER NUMBER		
3774				
MAIL DATE		DELIVERY MODE		
08/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,130

Applicant(s)

TWOMEY ET AL.

Examiner

ANN SCHILLINGER

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3.5 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3.5 and 8-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8, 12, 13, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan (US Pat. No. 5,935,169) in view of Ralph et al. (US Pub. No. 2003/0065395). Chan discloses the following of the claimed invention: a bone cement plug for fitting into the intramedullary canal within a bone to restrict flow of bone cement during surgery, which comprises: a. a sleeve (105) whose inner surfaces define an internal cavity (120) which communicates with an opening (on element 25) formed in the outer surface; an expander (110) comprising a shaft (140) and a traverse portion (145) where the shaft extends through the opening and moves to cause the sleeve to expand (col. 6, lines 10-40). The sleeve has surface features (170A-C) and an indent (167). Please also see Figures 5 and 6. Chan also discloses an instrument (200A) with a socket (250A), and drive unit (225A) (col. 11, lines 15-48).

However, Chan does not disclose including washers with the expander. Ralph et al. teaches a prosthetic device that uses washers in paragraphs 0030-0037 for the purpose of helping the prosthesis to maintain its desired shape. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use washers with the expander in order to secure the desired shape of the device.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Ralph et al., as shown in claim 1, further in view of Spierings (US Pat. No. 6,669,733). Chan, as modified by Ralph et al., discloses the invention substantially as claimed, however, Chan does not disclose an expander where the shaft can break. Spierings teaches an expander where the shaft can break in col. 4, lines 25-40 for the purpose of causing the maximum compression force on the body to obtain a strong fixation of the prosthesis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an expander where the shaft can break in order to cause the maximum compression force on the body to obtain a strong fixation of the prosthesis.

Claims 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Ralph et al., as shown in claims 1, further in view of Evans et al. (US Pat. No. 7,156,880). Chan, as modified by Ralph et al., discloses the invention substantially as claimed, however, Chan does not disclose using resorbable materials. Evans et al. teaches using resorbable materials in col. 25, lines 33-61 for the purpose of leaving a larger effective porosity. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use resorbable materials in order to leave a larger effective porosity.

Claims 10, 11, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Ralph et al. Chan as modified by Ralph et al., discloses the invention substantially as claimed, however, Chan does not disclose the angles of expansion and the specific material hardness measurements disclosed by the Applicant. It would have been obvious to one having ordinary skill in the art at the time

Art Unit: 3774

the invention was made to use these values, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 5, and 8-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

Art Unit: 3774

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann Schillinger/
Examiner, Art Unit 3774

/DAVID J ISABELLA/
Supervisory Patent Examiner, Art Unit 3774